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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,057	04/08/2004*	Robert J. Tynik	101221-680	2099

27387 7590 06/01/2007
NORRIS, MCLAUGHLIN & MARCUS, P.A.
875 THIRD AVE
18TH FLOOR
NEW YORK, NY 10022

EXAMINER

GOLOBOY, JAMES C

ART UNIT	PAPER NUMBER
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1714

MAIL DATE	DELIVERY MODE
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06/01/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/822,057	TYNIK, ROBERT J.	
	Examiner	Art Unit	
	James Goloboy	1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 21, 23, 30-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-13 and 30-38 is/are allowed.
- 6) ☒ Claim(s) 1-10, 21, 23 and 39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. While the rejections set forth in paragraphs 4 and 5 below utilize the same combinations of references as in the office action mailed 12/11/06, some further explanation of those references has been necessitated by applicant's amendments of 3/12/07.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 21 and 23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 21 has been amended to require a metal acid hydrate of the formula $\text{MO}_4\text{H}_2 \cdot 2\text{H}_2\text{O}$. There is no support in either the specification or the claims as originally filed for the metal acid dihydrate, only the monohydrate. The applicant is advised that while the currently amended claim has been rejected below, should the applicant amend the claim to recite the monohydrate, it would be rejected over de Roch in view of Freedman as discussed below.

Claim Rejections - 35 USC § 103

4. Claims 1-2, 4-10, 21, 23, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over de Roch (U.S. Pat. No. 3,489,775) in view of Freedman (J. Am. Chem. Soc., 1959, 81, p. 3834-3839).

The rationale for the rejections of claims 1-2 and 7-10 is set forth in paragraph 8 of the office action mailed 12/11/06, which is incorporated here by reference. Amended claims 4-6 are rejected for the same reasons as claims 7-8. Claims 21, 23, and 39 have been amended to require that the metal acid hydrate be formed in water, and that the metal acid hydrate be reacted with an alkylamine in water as well. In column 4 line 19 de Roch teaches that the reaction between the metal acid hydrate and alkylamine can take place in water, as recited in claims 21(b), 23, and 39. Freedman teaches on page 3835, column 1, paragraph C that the metal acid hydrate is formed by the reaction of sodium metal dehydrate with 6.0 N HCl, which is a solution of hydrochloric acid and water. The formation of the metal acid hydrate therefore takes place in water, meeting the limitations of claims 21(a) and 23.

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over de Roch in view of Freedman as applied to claims 1-2 and 9-10 above, and further in view of Krause (J. Am. Chem. Soc., 1925, p. 1689-1694).

The rationale for this rejection is set forth in paragraph 9 of the office action mailed 12/11/06, which is incorporated here by reference.

Allowable Subject Matter

6. Claims 11-13 and 30-38 are allowed. Applicant has presented a rule 132 declaration by Tynik, dated 3/12/07. Paragraph 3 of the declaration persuasively argues that it would not have been obvious to use oil-soluble tungstates oil-based lubricating compositions to achieve an analogous corrosion inhibiting effect to that described by Kuwamoto (US. Pat. No. 4,626,367) for water-soluble tungstates in aqueous lubricants. Specifically, the declaration states that the oil-soluble tungstates do not dissociate into tungstate or molybdate ions even when dissolved in oil. In light of this, the rejection of claims 11-13 in the prior office action is withdrawn.

An updated search produced two additional relevant prior art references.

Spengler (U.S. Pat. No. 3,114,712) discloses a lubricating composition comprising a "solution of molybdates of organic nitrogen bases in mixtures of monothiophosphoric acid dialkyl esters and alkyldithiophosphoric acid esters" (column 1 lines 42-45). In column 1 lines 46-61 Spengler teaches that the molybdates can be formed by the reaction of a dialkylamine and a molybdic acid, and that the alkyl groups can contain up to 18 carbon atoms. However, from the description in column 2 lines 17-30, it is clear that these molybdates react with the thiophosphoric acid esters, and the final additive used in the lubricant is not a molybdate meeting the limitations of claim 11.

Saini (PG Pub. No. 2003/0119682) discloses a lubricant formulation, and in paragraphs 73-75 teaches that the formulation preferably comprises an oil-soluble organomolybdenum additive. However, Saini does not disclose organomolybdenum

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compounds meeting the limitations of claim 11, and since de Roch only discloses molybdate compounds as epoxidation catalysts, there would have been no motivation to use the molybdates of de Roch as the oil-soluble organomolybdenum additives of Saini. Claim 11 is therefore allowed, as are claims 12-13 and 30-38, which depend on claim 11.

Response to Arguments

7. Claim 1 has been amended to limit the alkyl amines to dialkylamines where at least one alkyl group has between 8 and 40 carbon atoms. Applicant argues that de Roch only explicitly discloses dialkylamines containing shorter-chain alkyl groups. However, de Roch also teaches that the amines advantageously contain 1-50 carbon atoms per molecule, preferably 5-25. The vast majority of permutations of dialkylamines containing an amount of carbon atoms within those ranges meet the limitations of the dialkylamines of claim 1. The fact that de Roch does not exemplify such a dialkylamine does not constitute a teaching away. The rejections of claims 4-10 are also maintained for the reasons of record.

The rule 132 declaration of Tynik does not influence the rejections of claims 1-10, 21, 23, and 39, as it only deals with lubricating compositions comprising the organoammonium salts, and not the salts themselves.

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Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

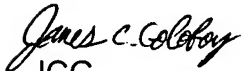
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Goloboy whose telephone number is 571-272-2476. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


JCG


VASU JAGANNATHAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700